

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

The issues raised on pages two and three of the Official Action concerning the terms "approximately" and "substantially" are noted. Applicants do not agree with the observation that these terms render the claims indefinite, particularly as such terms are commonly used in U.S. practice. Nevertheless, to advance prosecution of this application, the recitation in Claim 1 that the welded portion is made substantially smooth is deleted, and the terms "substantially" and "approximately" in other claims are also deleted.

With respect to the phrase "at least" in Claims 1 and 3, it is respectfully submitted that the claim language is not indefinite. The language in Claims 1 and 3 recites that the cover layer covers at least the welded portion, meaning that the cover layer can also cover other portions of the guide wire. There is nothing indefinite about this language as it clearly sets forth that the cover layer covers the welded portion, but can also cover other portions of the guide wire. Nevertheless, to advance prosecution of this application, the phrase "at least" has been deleted in Claims 1 and 3. Since the claims utilize the open-ended transitional phrase "comprising," the deletion of the term "at least" does not alter the claim scope as the recitation that the cover layer covers the welded portion does not exclude the possibility that the cover layer also covers other portions of the guide wire.

Finally, with respect to the observation in paragraph "6" at the top of page three of the Official Action, it appears the Examiner may not fully understand the claim language. The claim language in questions defines that the cover layer covers

the welded portion between the first wire and the second wire. Thus, the term "covering" is not used as a noun (i.e., a cover layer covering), but rather is used to recite that the cover layer covers the welded portion. In an attempt to make this more clear, Claim 1 is amended to recite "a cover layer provided on the outer periphery of said wire member and covering said welded portion between said first wire and said second wire."

In light of the foregoing, withdrawal of the claim rejections based on the second paragraph of 35 U.S.C. § 112 is respectfully requested.

Claims 1, 3 and 7-29 remain readable on the elected species. New Claims 30 and 31 are also readable on the elected species. New Claims 32-35 directed to a method of manufacturing a guide wire are also presented by way of this Amendment.

The Official Action sets forth a rejection of independent Claims 1 and 3 based on the disclosure in U.S. Patent No. 5,769,796 to *Palermo et al.* This reference discloses a first wire member 142, and a second wire member 146 located distally of the first wire member 142. The Official Action observes that *Palermo et al.* also discloses a welded region 177 joining the first and second wire members. As discussed beginning of column 7 of *Palermo et al.*, the embodiment of the guidewire illustrated in Fig. 7 includes a core 175 and a tubular metallic braid 177 bonded to the core 175 by adhesives or solder or by welding. Thus, *Palermo et al.* describes in connection with the Fig. 7 embodiment that the guidewire includes a braid 177 overlying the core 175, with the braid being connected to the core 175 by, for example, welding. In this regard, *Palermo et al.* does not describe that the core 175 includes first and second wires welded to one another (e.g., the wires 142, 144) illustrated in connection with earlier embodiments of the guidewire.

Nevertheless, to more clearly distinguish the claimed guide wire over the disclosure in *Palermo et al.*, Claim 1 has been amended to recite that the first wire and the second wire each possess an end face, with the end face of the first wire and the end face of the second wire being welded to one another at a welded portion so that the first and second wires do not axially overlap one another. This language is supported by the illustration in Fig. 3 of the present application. As clearly shown in Fig. 2 of *Palermo et al.*, the first and second wires 142, 144 axially overlap one another. Thus, the guide wire recited in Claim 1 is patentably distinguishable over the *Palermo et al.* disclosure.

With respect to independent Claim 3, the Official Action notes the illustration in Fig. 10 of *Palermo et al.* showing a polymeric tie layer 204 disposed on a metallic core 202, and a coating 206 disposed on the tie layer 204. To more clearly distinguish over this disclosure of coextensive layers 204, 206, Claim 3 is amended to recite that the cover layer and the distal-side cover layer do not axially overlap one another such as illustrated in Fig. 3. Quite clearly, this is not the case with the layers 204, 206 disclosed in *Palermo et al.*

For at least the foregoing reasons, it is respectfully submitted that the claimed guide wire is patentably distinguishable over the guidewire disclosed in *Palermo et al.* Accordingly, withdrawal of the rejections of record is respectfully requested.

The dependent claims define further distinguishing characteristics associated with the claimed guide wire. However, as these dependent claims are allowable at least by virtue of their dependence from allowable independent claims, a detailed discussion of the further distinguishing characteristics recited in the dependent claims is not set forth at this time.

Finally, new Claims 33-35 are presented and define a method of manufacturing a guide wire. Independent Claim 32 recites that the method comprises welding a first wire to a second wire at a welded portion to form a wire member in which the first wire is disposed on the distal side of the second wire, covering the outer periphery of the wire member at the welded portion with a cover layer while the wire member is not heated, and covering the outer periphery of the wire member on a distal side of the cover layer with a distal-side cover layer while heating the wire member. This claimed method is not disclosed in *Palermo et al.* and is thus also allowable.

Early and favorable consideration of this application is respectfully requested.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

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